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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

In Re ACADIA MEDIA TECHNOLOGIES CORPORATION	Case No. C-05-0114JW **ROUND 3 DEFENDANTS' CLAIM CONSTRUCTION BRIEF (PART I)** Date: June 2, 2006 Time: 9:00 a.m. Courtoom: 8, 4th Floor Judge: Honorable James Ware

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Correlation of Round 3 Defendants Memorandum (Part I) to Joint Claim Chart [1]

Memorandum Part I	**Claim Term**	**Joint Claim Construction Chart**
Point I	"A distribution method responsive to requests from a user identifying items in a transmission system containing information" ('992 patent, claim 19; '275 patent, claims 2 and 5)	#1, #5
Point II	"Storing, in the transmission system, information from items in a compressed data form, the information including an identification code and being placed into ordered data blocks" ('992 patent, claims 19 and 47; '275 patent claims 2 and 5)	#3
Point III	"To the one of the receiving systems at one of the remote locations selected by the user" ('992 patent, claim 47) "The receiving system at one of the remote locations selected by the user" ('992 patent, claim 47) "The receiving system at the selected remote location" ('992 patent, claims 19 and 47)	#2, #8
Point IV	"Playing back ... at a time requested by the user" ('992 patent, claim19; '275 patent, claims 2 and 5)	#6
Point V	"Sending at least a portion of the stored information from the transmission system" ('992 patent, claims 2 and 5)	#9, #47
Point VI	The order of the various steps in method claims ('992 patent, claim 19 and '275 patent, claims 2 and 5)	#10, #49
Point VII	"Wherein the information in the items includes analog and digital signals" ('992 patent, claims 20 and 48) "Ordering the converted analog signals and the formatted digital signals into a sequence of addressable blocks" ('992 patent, claim 20)	#11

[1] When preparing the Joint Claim Chart ("JCC"), Acacia did not adopt the order in which the terms were presented in the Round 3 defendants' claim construction chart. Therefore, this chart mapping the sections of this memorandum to the JCC is provided for the Court's convenience. In addition, with each Point heading in the body of this memorandum, we indicate the associated entry or entries in the JCC.

Point VIII	"Comprising the steps, performed by a transmission system, of" ('992 patent, claim 41) "Comprises the steps, performed by a transmission system" ('992 patent, claim 20)	#18
Point IX	The order of the steps ('992 patent, claim 20)	#12
Point X	The order of the steps ('992 patent, claim 21)	#13
Point XI	"The step of storing includes the step of storing the received information at the head end of a cable television reception system" ('992 patent, claim 23)	#14
Point XII	The order of the steps ('992 patent, claim 23)	# 15
Point XIII	"The step of storing includes the step of storing the received information in an intermediate storage device" ('992 patent, claim 24) "Wherein the memory means is an intermediate storage device" ('992 patent, claim 53)	#16, #43
Point XIV	The order of the steps ('992 patent, claim 24)	#17
Point XV	"Compressing the formatted and sequenced data blocks" ('992 patent, claim 41)	#20
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Point XVII	The order of the steps ('992 patent, claim 41)	#22
Point XVIII	The order of the steps ('992 patent, claim 42)	#23
Point XIX	The order of the steps ('992 patent, claim 43)	#24
Point XX	The order of the steps ('992 patent, claim 44)	#25
Point XXI	"Separately storing a plurality of files, each including compressed, sequenced data blocks" ('992 patent, claim 45)	#26
Point XXII	The order of the steps ('992 patent, claim 45)	#27
Point XXIII	"Receiving transmission requests to transmit available items" ('992 patent, claim 46)	#28
Point XXIV	The order of the steps ('992 patent, claim 46)	#29

Point XXV	"Sending a request, by the user to the transmission system, for at least a part of the stored information to be transmitted to a reception system associated with a receiving system at one of the remote locations selected by the user" ('275 patent, claims 2 and 5)	#45
Point XXVI	"Playing back the stored copy of the information from the reception system to the receiving system at the selected remote location at a time requested by the user" ('275 patent, claims 2 and 5)	#4, # 46, #48
Point XXVII	"User" ('992 patent, claims 19 and 47; '275 patent, claims 2 and 5)	#7

Preliminary Statement[2]

In its opening brief, Acacia faults defendants for the large number of claim terms in dispute and for the length of its own 108 page brief. Acacia complains that defendants' contention that so many claim terms are invalid has "unnecessarily expanded the subject matter of these Markman proceedings." (Acacia Br. p. 2.) It also attributes the length of its brief to this and to the fact that the Round 1 and Round 2 defendants have different constructions than the Round 3 defendants. (*Id.*) Acacia directs its frustration at the wrong parties. The reason for this inordinate degree of complexity is that the specification and claims of the Yurt patents largely make no sense.[3]

The Federal Circuit recently reaffirmed in *Phillips* that claims "must be read in view of the specification, of which they are a part." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) ("[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.") The common specification of the Yurt patents, however, does not disclose a consistent or comprehensible embodiment against which the claims can be compared. The specification discloses a system made up of components which are not described and are not known in the art, and which are often represented in the specification as only "blocks" on the page with a one or two word name. The "sequence encoder" and the "identification encoder" are two examples of this. The descriptions of the functions performed by the system are no more illuminating.

The patent applicants' own technical consultants at the Sarnoff Institute told them this at least as early as 1992. Greenwich Technologies, a company owned or controlled by applicant H. Lee Browne, commissioned the David Sarnoff Research Center to do an evaluation of the patent specification. While employing the same tact that consultants (and lawyers) frequently use when

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2 In this memorandum the references to column and lines (e.g., col. 1:7-8, meaning column 1 lines 7-8) refers to the '992 patent unless otherwise noted. Italics and boldfacing are supplied for emphasis but are not uniformly noted as being added.

3 The Yurt patents are U.S. Patent Nos. 5,132,992, 5,253,275, 5,550,863, 6,002,720 and 6,144,702.

communicating with clients, the authors conveyed the message that the disclosure was so lacking that there was little for them to evaluate:

> The general principles of the system outlined in the patent document appear to be technically correct, though *lacking in specific details particularly at the subsystem level*. While the document may serve as a useful starting point for further development, *significant additional design / simulation / prototyping work will be required* for a meaningful "proof-of-concept." (Benyacar Decl. Ex. A, p. 3.)

The claims of the patents are as poorly conceived and drafted as the specification. Some of the claims are plainly self-contradictory. Many are indefinite. And, those claim terms that are clear frequently describe functions and apparatus which do not appear in the specification at all.

Nonetheless, the Round 3 defendants[4] put forth the only possible constructions of the disputed terms that have a basis in the claim language, the specification and the prosecution history. We also indicate when a claim term cannot be construed, and is therefore indefinite.[5] This memorandum addresses all of the disputed terms except for the means-plus-function terms (terms 30-42 in the Joint Claim Chart), which are addressed in Part II of the Round 3 defendants' memorandum. For the reasons provided, the Court should adopt the Round 3 defendants' constructions of the disputed terms.[6]

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[4] The Round 3 defendants are Time Warner Cable Inc. and CSC Holdings, Inc., which were sued by Acacia almost a year after the Round 2 defendants were sued, and which were only added to this MDL Proceeding on February 23, 2006. The use of "our" or "we" herein refers to the Round 3 defendants.

[5] Because a construction is provided does not mean the Round 3 defendants believe a term or claim is definite, as Acacia suggests. (Acacia Br. p. 2.) The Round 3 defendants will make separate invalidity motions during the time for filing such motions as directed by the Court.

[6] Pursuant to the Court's instructions at the February 24, 2006 scheduling conference, the Round 3 defendants will address terms the Court has previously construed (with respect to which the Round 3 defendants have not yet had the opportunity to be heard) during the August 11, 2006 *Markman* hearing. As such, the Round 3 defendants have not provided herein their positions on or proposed constructions of these previously-construed terms. The previously-construed terms (and/or portions thereof) which the Round 3 defendants presently intend to address at the August 11 hearing include: "transmission system"; "reception

POINT I (JCC # 1, #5)

"A DISTRIBUTION METHOD RESPONSIVE TO REQUESTS FROM A USER IDENTIFYING ITEMS IN A TRANSMISSION SYSTEM CONTAINING INFORMATION" ('992 patent, claim 19; '275 patent, claims 2 and 5)

Round 3 Defendants' Proposed Construction

A user request must contain an identifier of physical items containing information that has not yet undergone the compression recited in the first "storing" step. The physical items must be in the transmission system such that this information can be retrieved from the physical items in response to user requests.

Argument

A. The Preamble Is A Claim Limitation

Contrary to plaintiff's contention, the identical preambles of claim 19 of the '992 patent and claims 2 and 5 of the '275 patent are claim limitations.[7]

According to the Federal Circuit, a preamble "is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim." *Bicon, Inc. v. Straumann Co.*, 2006 U.S. App. LEXIS 6813 *17 (Fed. Cir. March 20, 2006). *Accord Poly-America, L.P. v. GSE Lining Tech., Inc.*, 383 F.3d 1303, 1309 (Fed. Cir. 2004). "[I]f the claim drafter 'chooses to use *both* the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.'" *Bicon*, at

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system" (and the related term "receiving system"); "storing items having information in a source material library"; "items containing information" (and the related term "items having information"); "remote locations" (as used in claim 41 of the '992 patent); "retrieving the information in the items from the library means" (and the related term "retrieving the information in the items from the source material library"); "assigning a unique identification code"; "placing the formatted data into a sequence of addressable data blocks" (and the related term "ordered data blocks"); "storing, as a file, the compressed, formatted, and sequenced data with the assigned unique identification code"; and "retrieve."

[7] Acacia's position that the preamble is not a limitation is a brand new one. As recently as February 27, 2006, Acacia served a Disclosure of Asserted Claims and Preliminary Infringement Contentions to Time Warner Cable, Inc. which set forth Acacia's contentions as to how TWC satisfies the limitations in the preambles of claim 19 of the '992 patent and claims 2 and 5 of the '275 patent.

*17 (*quoting Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995)). On the other hand, "a preamble is not limiting 'where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use of the invention.'" *Poly-America*, 383 F.3d at 1310. As shown below, the applicants used the preambles to define the claimed invention. These preambles are therefore claim limitations.

1. Claim 19 of the '992 patent

Catalina Marketing Int'l Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808 (Fed. Cir. 2002), on which Acacia relies, states that "[n]o litmus test defines when a preamble limits claim scope. Some guideposts, however, have emerged from various cases discussing the preamble's effect on claim scope." (Citation omitted.) Those "guideposts" -- ignored by Acacia -- demonstrate that the preamble of claim 19 limits the claim.

a. the preamble provides antecedent basis

One of the guideposts most frequently used by courts to determine if a preamble is a limitation is whether the preamble provides the antecedent basis for limitations in the body of the claim. "[W]hen the limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention." *Bicon* at **17-18; *see also Catalina Marketing*, 289 F.3d at 809. The claim 19 preamble provides the antecedent basis for *four different terms* used in the body of the claims: "the user," "the transmission system," "the receiving systems," and "the remote location."[8]

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[8] The first time a claim refers to an object, it should be preceded by the indefinite article *a* or *an* to establish the "antecedent basis" for subsequent references to that object. Subsequent references can then be modified with either *the* or *said*, e.g., "the lever" or "said lever", because the referent for the noun has been identified. If "the lever" was used in the claim as the first reference to a lever, the term would lack proper antecedent basis. M.P.E.P. 2173.05 (e); *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1306 (Fed. Cir. 2005).

Claim 19's reliance on its preamble to provide antecedent basis for terms in the body of the claim is even more extensive than the claim at issue in *Bell Communications Research v. Vitalink Communications*, 55 F.3d 615 (Fed. Cir. 1995), where the court found the preamble limiting. The preamble in *Bell Communications* recited a "method for transmitting *a packet* . . . said packet including a source address and a destination address." The body of the claim contained two elements which referred to "said packet," thereby relying on the preamble for antecedent basis. *See* 55 F.3d at 621 ("assigning, by said source device, one of said trees to broadcast *said* packet and associating with *said* packet an identifier indicative of said trees"). The patentee argued that the preamble was not a limitation. The Federal Circuit disagreed, holding that the reference to "said packet" in the body of the claim incorporated the entire description of the packet from the preamble into the claim as limitations:

> These two steps of the claimed method, by referring to "*said* packet," expressly incorporate by reference the preamble phrase "said packet including a source address and a destination address." As a result, only a method for transmitting packets that have *both* source *and* destination addresses can literally infringe [the claim]. *Id*. at 621.

See also Electro Sci. Indus. v. Dynamic Details, Inc., 307 F.3d 1343, 1348 (Fed. Cir. 2002) ("References throughout the rest of the claim to 'circuit boards' rely upon and derive antecedent basis from this preamble language. Therefore, this preamble definition limits the term 'circuit boards' throughout the claim.")

Here, as discussed above, the body of claim 19 relies on the preamble for antecedent support of *four terms* used in the body of the claims, not just one as in *Bell Communications*. Thus, the "antecedent basis" guidepost alone demonstrates that the preamble of claim 19 is limiting.

b. the preamble recites important steps

A second guidepost used by courts to determine when a preamble limits a claim is whether the preamble recites important structure or steps. "[W]hen reciting additional structure or steps underscored as important by the specification, the preamble may operate as a claim limitation." *Catalina Marketing*, 289 F.3d at 808. The preamble of claim 19 adds to the method described in the body of the claim the requirement that (i) "items . . . containing information" are located in the transmission system; and (ii) the user "request" must identify such "items." The patent specification repeatedly emphasizes that user identification of an item containing information (a physical item in the source material library)[9], and not the information itself (as stored, for example, in the compressed data library), is an important aspect of the invention. The specification says:

- "the present invention comprises a receiving system responsive to a *user input identifying a choice of an item stored in a source material library* to be played back to the subscriber at a location remote from the source material library, *the item containing information* to be sent from a transmitter to the receiving system" (Col. 2:62-68);

- "the first step of the distribution method 400 involves *retrieving the information for [sic from] selected items in the source material library 111, upon a request by a user* of the distribution system (step 412). " (Col. 18:53-56.)[10]

Consistent with the importance the applicants placed on this aspect of the invention, they relied on it to distinguish prior art. For example, they distinguished their invention from a prior art Lang patent on the grounds that "Lang does not teach that user requests will cause items stored in a source material library to be sent from a transmitter to a receiving system." (Petition to Make Special, Benyacar Decl. Ex. B, p. 7; *see also* '992 Col. 1:48-56.) The applicants also stated that

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[9] See Point I (C) *infra*.

[10] While describing the process for retrieving information in response to user requests, the specification sometimes states that user requests are made to the source material library, and at other times states that user requests are made to the compressed data library. These are not descriptions of alternative methods; they are self-contradictory descriptions of the same method. The two consecutive paragraphs at 18:46-59, for example, describe the same method 400 depicted in Figure 7. The first paragraph says "[m]ethod 400 assumes that the items have already been stored in compressed data library 118" (18:50-52), while the second paragraph says "the first step of the distribution method 400 involves retrieving the information for selected items in the source material library 111, upon a request by the user of the distribution system." Claim 19 closely tracks this description of method 400. Claim 19, like the specification, describes a single method in which user requests identify physical items in a source material library and are "for" compressed information. Because the claim is directed to the same incoherent method disclosed by the specification, the preamble of claim 19 cannot be ignored even if it renders the claim indefinite.

"[t]he entire system includes a transmission system and a reception system. *The transmission system includes a source material library from which a user makes a selection. The selected program is processed and compressed* for storage in a compressed data library." (*Id.* pp. 2-3.)

To determine whether steps in a preamble are important (and are therefore limiting), courts also consider whether the steps are contained in the body of other claims. *See Rohm & Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1091 n. 1 (Fed. Cir. 1997) (finding preamble limiting where terms also "appear in the body of several asserted claims"). If the applicant deemed the preamble terms important enough to include in the bodies of other claims, those terms are material and should also be treated as limitations in the preamble. Here, the requirement that the transmission system comprises "items" which "contain information" appears only in the preamble of claim 19. However, this limitation appears in the body of claims 1 and 41 (which uses the alternative construct "items having information").[11] In addition, the requirement that the user request identify an item in the source material library is a limitation in the body of claims 25 and 54.

c. reliance on the preamble during prosecution

In addition to the above guideposts, "clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention." *Catalina Marketing*, 289 F.3d at 808. The preamble of claim 19 was amended by the applicants in overcoming prior art rejections. For example, application claim 18 (which issued as claim 19) was rejected in a December 10, 1991 Office Action as obvious over certain Abraham, Ulicki and Keith prior art references. (Benyacar Decl. Ex. C, p. 3.) The applicants then had an interview with the examiner, who noted in his interview summary that he had provided "comments" about several claims, including application claim 18, and stated that he would "[r]econsider the allowability of the claims upon submission of . . . amendments." (Benyacar Decl. Ex. D.) The applicants then amended the preamble of application claim 18 in a December 26, 1991 Amendment as follows (additions underscored):

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[11] This limitation was added to both claims 1 and 19 (application claim 18) at the same time, in an October 1, 1991 Amendment (Benyacar Decl. Ex. E, pp. 2 and 5), in response to examiner rejections of both claims. Claim 41, containing this same limitation, was added to the application in this same amendment, and was represented to the examiner as "correspond[ing] generally" to claim 1 (*Id.* at 17) and as therefore being allowable for the same reasons as claim 1 (*Id.* at 26). The same amendment made to three different claims in response to examiner rejections, at the same time, could not have been intended as a limitation of two of the claims but not the third.

> A distribution method responsive to requests from a user identifying items in a transmission system containing information to be sent from [a] the transmission system to receiving systems at remote locations, the method comprising the steps of:

(Benyacar Decl. Ex. F, p. 2.) Corresponding changes were made to the body of the claim as well. The applicants confirmed in their accompanying remarks that the amendments were made at the examiner's direction to overcome the previous rejections. (*Id.* at 10.) Thus, it is clear that both the examiner and the applicants understood that the preamble of claim 19 limited the claim.

d. claim 20 further limits the claim 19 preamble

Finally, claim 20 of the '992 patent also demonstrates that the preamble of claim 19 provides important structure, not mere context and purpose, and is therefore a limitation. Claim 20 limits claim 19 by requiring, *inter alia*, that analog and digital signals be included in the "information *in* the items," not "information *from* the items."[12] The existence of information as it is stored in the items (that is, information that has not yet been retrieved from the items) appears only in the preamble of claim 19.

e. Acacia's cases do not support its argument

For all of the reasons stated above, the preamble of claim 19 differs from the preambles at issue in the *Catalina Marketing* and *Intirtool* cases relied on by Acacia. The preambles in those cases did not provide antecedent basis for limitations in the body of the claims, did not define important aspects of the invention, were not relied on by the applicants during prosecution to distinguish prior art, and were not further limited by dependent claims. Moreover, the preambles in those cases were directed to intended *uses* of claimed apparatus. *See Catalina Marketing,* 289 F.3d at 810 (claimed terminal would be placed at a "consumer store"); *Intirtool, LTD v. Texar Corp.,* 369 F.3d 1295 (Fed. Cir. 2004)(claimed punch pliers would be used "for simultaneously punching and connecting overlapping sheet metal"). Thus, the body of the claims in each case fully described the structure of the apparatus, and the preambles merely indicated how the apparatus could be used. In contrast, the preamble of claim 19 places limits on some of the steps in the body of the claim. It does not describe an intended use of the overall method. Accordingly, the Court should find that the preamble limits the claim.

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[12] Although this clause is in the preamble of claim 20, Acacia concedes this preamble is a limitation. (Acacia Br. p. 33 (claim 20 "adds the limitation that the information in the items includes analog and digital signals...")).

2. Claims 2 and 5 of the '275 patent

The preambles of claims 2 and 5 of the '275 patent, which are identical to the preamble of claim 19 of the '992 patent, are also claim limitations. The '275 patent is a continuation from the '992 patent. Common terms used in claims of related patents should be similarly construed. *Arthur A. Collins v. Northern Telecom,* 216 F.3d 1042, 1044 (Fed. Cir. 2000) (court "determined that a common construction of" a limitation in the claims of two related patents "was appropriate"); *see also Phillips v. AWH Corp.,* 415 F.3d 1303, 1314 (Fed. Cir. 2005) (*en banc*) ("[c]laim terms are normally used consistently throughout the patent."). Moreover, claims 2 and 5 of the '275 patent track claim 19 of the '992 patent by design.[13] Thus, the preambles of '275 claims 2 and 5 are limitations for the same reason the preamble of '992 claim 19 limits that claim.

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[13] The applicants told the examiner when claim 2 ('275 application claim 18) was filed that it had the same scope as '992 claim 19 (allowed in claim 18) "but add[s] a reception system located at the head end of a cable television reception system." ('275 4/2/92 Preliminary Amendment; Benyacar Decl., Ex. H, p. 5.) Claim 5 was added in an amendment dated January 12, 1993 (as application claim 34) for the purpose of adding "the distribution media" (the "optical fiber communication path") to claim 2. (Benyacar Decl., Ex. I, pp. 2-3.) Neither of these differences from claim 19 affect the preamble's role in limiting the claim.

B. The Intrinsic Evidence Supports Round 3 Defendants' Interpretation

The language of the claims, the specification and the prosecution histories all support Round 3 defendants' construction of "distribution method responsive to requests from a user identifying items in a transmission system containing information," namely:

> A user request must contain an identifier of physical items containing information that has not yet undergone the compression recited in the first "storing" step. The physical items must be in the transmission system such that this information can be retrieved from the physical items in response to user requests.

The language of the term itself makes clear that:

- the "user requests" must "identify[] [*e.g.* contain an identifier for] items ... containing information";
- the "items" must be "in [the] transmission system"; and
- the "distribution method" is "responsive to" these user requests, requiring the information in the items to be retrieved and distributed in response to these user requests.

The requirement that the information in the items referred to in the preamble "has not yet undergone the compression recited in the first 'storing' step" follows from the language in the first storing step which requires compression after the information is taken "from items."[14] (See infra Point II.)

The specification and the prosecution history confirm this construction. As described in Point I (A)(1)(b), they state repeatedly that a user request for information contained in physical items in the source material library triggers retrieval and processing of the information in the item.

C. "Items Containing (Or Having) Information"

Relying solely on its contention that the preambles of claims 19, 2 and 5 are not claim limitations, Acacia proposes no construction of its own. However, in a different part of Acacia's brief, it disputes that the term "items ... containing information," which appears in the preamble, requires that items be physical objects. (Acacia Br. p. 19.) Because the Court has previously construed this term, the Round 3 defendants will be heard on the construction of this term during the August 11, 2006 Markman hearing.[15]

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[14] Figure 2 and its associated description also teach that compression occurs *after* the information is retrieved from the physical items in the source material library. See, e.g., the location of "compressor" 116 in Fig. 2a relative to the source material library 111 to which the user's requests identifying "items . . . containing information" are made.

For now, however, we observe only that Acacia is correct that the term "items" is used in the specification in several different ways. As Acacia acknowledges (Acacia Br. 17-18), the specification uses the term "items of information" to refer to the "information" in the source material library (Col. 5:66-6:15) and to "compressed information" stored in the compressed data library. (Cols. 6:35-39; 8:48-52; 11:25-28; 12:55-57.) However, the word "item," when used in the phrase "items containing information" in the preambles of claims 19, 2 and 5, cannot refer either to the "information" itself or to "items" in the compressed data library. Rather, the "items containing information" in the preamble must be physical objects that "contain information," which the specification also describes. (*See*, e.g., cols. 6:10-15; 18:53-59.)

POINT II (JCC # 3)

"STORING, IN THE TRANSMISSION SYSTEM, INFORMATION FROM ITEMS IN A COMPRESSED DATA FORM, THE INFORMATION INCLUDING AN IDENTIFICATION CODE AND BEING PLACED INTO ORDERED DATA BLOCKS" ('992 patent, claims 19 and 47; '275 patent, claims 2 and 5)

Round 3 Defendants' Proposed Construction

This claim term requires all of the following steps, in the stated order:

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[15] Acacia states that: it "does not believe that the Court has construed the term 'items containing (or having) information' in any prior Markman decision;" the Round 3 defendants did not provide Acacia with a citation to the portion of the Court's Markman Order where the Court construed the term; and that the Round 3 defendants are therefore required to brief their construction of "items containing (or having) information" now. (Acacia Br. p. 20.) In fact, the Round 3 defendants did provide Acacia with the citation it requested in an e-mail sent to Acacia attorney Alan Block on April 16, 2006 at 6:01 p.m. Eastern Time. Moreover, Acacia admits that the Court previously construed the term, and quotes the Court's prior construction, just 4 pages earlier. (Acacia Br. p. 16.)

(i) obtaining information, including an (one) identification code, from the plurality of (two or more) physical items which identifies all of the information retrieved from the plurality of items;

(ii) placing the information that is obtained from the plurality of physical items into a single set of ordered data blocks;

(iii) compressing the information which is in the single set of ordered data blocks; and

(iv) storing the compressed information "in the transmission system."

Argument

A. The Actions Described In The "Storing" Step

The first "storing" step of '992 claims 19 and 47 and '275 claims 2 and 5 is convoluted. Nevertheless, this step indisputably encompasses multiple actions. The claim provides that before the information is stored, it must be obtained "from items," "placed" in ordered data blocks and then "compressed," in that order.[16] On this, Acacia and the Round 3 defendants agree.

Acacia, however, argues that although the claim requires that ordering and compressing occur, in that order, before the information is stored, somehow the claim does not actually require ordering and compressing. Acacia argues that the storing limitation requires "only the single step of 'storing' information which was previously placed into ordered data blocks and which was previously compressed (in that order)." (Acacia Br. at 31.) Acacia's construction makes no sense in view of its agreement that the steps must be performed, and performed in order. Either the claim requires that the steps be performed, in which case they limit the claim, or the steps need not be performed at all. Because Acacia agrees that the ordering and compressing steps must be performed, those steps are claim limitations.

Acacia's construction is also inconsistent with the claim's plain language. For example, the phrase "being placed into ordered data blocks" is in the progressive tense - it describes an action that is ongoing.[17] "Being placed into ordered data blocks" must therefore occur as part of the step of storing. "Being placed" cannot describe something that has already been completed.

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[16] Although the step of obtaining the information from the items in the transmission system is not stated explicitly in the claim, the information necessarily must be obtained given that the claim describes the information as being "from items." The specification confirms that "[a]s illustrated in Fig. 7, the first step of the distribution method 400 involves retrieving the information..." (Col. 18:53-54.)

Finally, Acacia's construction of claim 19 is inconsistent with claim 20, which depends from claim 19. Claim 20 says that claim 19's first step of storing includes "ordering" the signals into data blocks and "compressing" the ordered information. If, per Acacia's reading of claim 19, the information must have been "previously" ordered and compressed, then dependent claim 20 could not require those same steps be performed during the "storing" step.

B. The Identification Code

The plain language of the claim requires that the identification code be retrieved from the plurality of physical items which contain the information. The claim says that the "information [is] from items" and that "*the* information include[s] an identification code." It is settled law that the use of the word "the" refers to the previous instance of the thing described. M.P.E.P. 2173.05 (e); *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1306 (Fed. Cir. 2005) ("It is a rule of law well-established that the definite article 'the' particularizes the subject which it precedes."). Acacia asserts that "[t]he identification code is not 'information from items,'" relying on excerpts from the specification (Acacia Br. p. 10). The specification, however, cannot be used to contradict the plain language of the claim. *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 990 (Fed. Cir. 1999).

Acacia also asserts that the "claim language does not support limiting this phrase to a single identification code" because "an" means "one or more" and because the patent uses the "the transitional phrase 'comprising.'" (Acacia Br. pp. 11-12.) We agree that there can be more than one identification code retrieved from the items.[18] The claim only requires that there be at least one identification code that identifies the totality of the information from all of the items. The claims do not cover using one or more identification codes each of which only identifies the information from a single item.

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[17] Acacia asserts that the use of the words "placed" and "compressed" supports its argument that the information from the "items" in the transmission system must be "placed" in ordered blocks and "compressed" before the claimed distribution method begins. (Acacia Br. p. 11.) However, the claim says "*being* placed," which means the placing is happening right now (in the context of claim 19, during the storing step). Acacia agrees that compression must occur after the placing step, meaning compression must also occur during, not before, the storing step.

Although Acacia contends that the claim ought not be limited to one "identification code," Acacia admits, as it must, that the claim is broad enough to cover only one "identification code."[19] Acacia's position that an "identification code" does not have to identify the information in all of the plurality of items, then, leads to the nonsensical result that some of the information stored in this first storing step is identified by an identification code, and other information is not identified by an identification code. The Round 3 defendants' construction does not suffer from this infirmity because the single identification code would correspond to the information from all of the items.

Acacia also argues that our construction requiring that "a single identification code [] identify all of the plurality of items" does not cover the preferred embodiment. (Acacia Br. pp. 12-13.) That is because, Acacia suggests, the preferred embodiment teaches only a one-to-one correspondence between items and identification codes. Since these claims require that there be a plurality of items, the claims must require "that there is a plurality of identification codes." (Acacia Br. p. 13.) Acacia ignores the fact that, pursuant to its own construction, the full breadth of the claims lacks support in the specification. The claims are admittedly broad enough to cover one identification code for multiple items. (Acacia itself argues that "an identification code" means "one or more" and that the claims refer to "information from items (plural)." (Acacia Br. pp. 11-12.)) Therefore, if Acacia is correct that the specification teaches only one identification code per item, then these claims are invalid under 35 U.S.C. § 112 because they lack written description. *See*

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[18] Round 3 defendants modified their construction to make this clear.

[19] Acacia concedes that the phrase "an identification code" should be construed to mean "one or more." (Acacia Br. pp. 11-12.)

Regents of the Univ. of Calif. v. Eli Lilly and Co., 119 F.3d 1559 (Fed. Cir. 1997) (full scope of claim must be supported by the specification); *In re Wilder*, 736 F.2d 1516, 1521 (Fed. Cir. 1984) (claiming a "genus of indicating mechanisms" that do not require synchronous scanning not supported by disclosing a "species" of an indicating mechanism that requires synchronous scanning).

Finally, Acacia repeatedly relies on what it says is the preferred embodiment to support its construction, while ignoring the plain language of the "storing, in the transmission system..." step. Courts will not, however, rewrite claims so that they read on the disclosure in the specification. *Allen Engineering Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1349 (Fed. Cir. 2002) (rejecting patentee's argument "that the term 'perpendicular' in the claim should be read to mean 'parallel' based on the specification."); *Chef Am., Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004) (claim construed to require that dough, rather than oven, be heated to 500º, even though specification taught that it was the oven that was heated to 500º and heating dough to this temperature would incinerate it: "[the Federal Circuit has] repeatedly and consistently [] recognized that courts may not redraft claims, whether to make them operable or to sustain their validity... Thus, in accord with our settled practice we construe the claim as written, not as the patentees wish they had written it.").

C. "Placed Into Ordered Blocks"

Acacia interprets the words "placed into ordered data blocks" to mean "time encoded." (Acacia Br. 8.) While it is difficult to imagine that such a broadly worded phrase can reasonably be understood so narrowly, this term will be addressed by the Round 3 defendants at the next stage of claim construction. At that time we will have our first opportunity to address the meaning of the related claim term "sequence of addressable data blocks," which the Court has already construed.

Whatever "ordered data blocks means," however, the information that is obtained from the plurality of physical items must be placed into a single set of them. "Ordered data blocks" is not a term which appears in the specification. To the extent it is definite (which the Round 3 defendants do not concede), it must relate somehow to "sequence of addressable data blocks." For the reasons discussed below in Point VII, however "*a* sequence of addressable data blocks" means that there is one and only one sequence.

POINT III (JCC # 2, #8)

"TO THE ONE OF THE RECEIVING SYSTEMS AT ONE OF THE REMOTE LOCATIONS SELECTED BY THE USER" ('992 patent, claim 19)

"THE RECEIVING SYSTEM AT ONE OF THE REMOTE LOCATIONS SELECTED BY THE USER" ('992 patent, claim 47)

"THE RECEIVING SYSTEM AT THE SELECTED REMOTE LOCATION" ('992 patent, claims 19 and 47)

Round 3 Defendants' Proposed Construction

> When the user requests "at least a part of the stored information," the user chooses the premises, from among a plurality of (two or more) premises, to which the information will be sent. Each of the premises from which the user chooses has a receiving system to which the information can be transmitted. The premises chosen by the user must be different from the premises at which the user makes the request.
>
> The request by the user to the transmission system "for at least a part of the stored information" must include an identification of the specific remote location selected by the user.

Argument

A. "Selected Remote Location"

The Round 3 defendants' construction of "selected remote location" is supported by the plain meaning of the claims, a meaning which corresponds exactly to a feature of the invention which applicants used repeatedly during prosecution and in the specification to distinguish prior art. In prior claim construction briefing Acacia even confirmed Round 3 defendants' construction when attempting to distinguish '992 claim 41 from claim 19. In addition, the Court's prior Markman ruling supports our, not Acacia's, construction. Acacia's attempts to vitiate this claim limitation must be rejected.

The specification makes clear that the word "remote," when used in the context of the user selecting a remote location to receive information, means remote from where the user is doing the selecting, not only remote from the transmission system. The specification states:

> [T]he user may *remotely access* the transmission system from a *location different than the location of [the] reception system where the material will be sent* and/or played back. Thus, for example, a user may preferably call [the] transmission system from work and have a movie sent to their house. (Col. 5:15-20.)[20]

The dictionary defines "select" as "chosen from a number or group by fitness or preference" Webster's Third New International Dictionary, p. 2058 (2002). This definition supports Round 3 defendants' construction and is consistent with the disclosure that the user can select "any location" that has a receiving system. (Col. 1:67 - 2:4.) Thus, "selected remote location" means the user chooses the premises, from among a plurality of (two or more) premises, to which the information will be sent. The term also requires that the premises that the user actually selects be a "remote location," a location different from the premises at which the user makes the request.[21]

The inventors considered the ability of the user to choose to have the requested information transmitted to a location other than the location from which the user makes the request fundamental to their invention. The specification relies on this aspect of the invention in distinguishing prior art:

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[20] By contrast, the specification never describes an embodiment where the user requests that information be sent to the location from which the user makes the request. Contrary to Acacia's assertion (Acacia Br. p. 26), the specification's discussion of Fig. 4 does not so provide. The method of Fig. 4 shows that "[a]fter the desired item is found, the user selects the item for transmission at a specific time and location." (Col. 15:20-22.)

[21] From the Round 1 and 2 defendants' construction, it appears they agree that the user must have the ability to select from a plurality of locations (premises), but they do not incorporate the requirement that the selection the user actually makes be a premises remote from where the user makes the selection. As such, the Round 1 and 2 defendants have incorporated the "selection" requirement, but they ignored the fact that "remote location selected by the user" and "selected remote location" plainly require that the user actually select one of the remote locations.

> While the [Walter] system affords the viewer some control over accessing the material, it requires that a location designated by the viewer be wired with a dedicated cable. *The Walter system further requires the viewer be at that location for both ordering and viewing the audio/video material.* (Col. 1:18-29; emphasis added.)

> Lang does not disclose a system with one or more libraries wherein a plurality of system subscribers may access information stored in the film and tape library or libraries, and *play back the selected information at a time and place selected by the subscriber*. (Col. 1:48-56; emphasis added.)

Acacia previously admitted to this Court, during claim construction briefing in its initial action against Round 1 defendants, that these distinctions over Walter and Lang in the specification applied to claim 19:

> There is no question that the inventors disclosed other embodiments for their invention, one of which included a user being able to select the location to which the transmission would be made. There is also no question that the inventors distinguished prior art references on this and many other grounds in the specification and prosecution history [citing, *inter alia*, to the above distinctions from Walter and Lang in the specification.] This was proper, because the inventors had pending claims, such as original claim 18 (claim 19 pf the '992 patent), which specifically stated that the transmission is to remote locations selected by the user. (Benyacar Decl. Ex. K, pp. 13-14 and n.6.)[22]

During prosecution, the applicants also distinguished claim 19 (then application claim 18) from prior art because the prior art did not teach requesting that information be sent to a location remote from the location where the request was made:

> Fenwick et al., also does not disclose a system in which a user can select a remote location to which a selected item is sent. Rather, in Fenwick et al., a selection can only be sent to the video monitor from which the user issues commands. . . (Benyacar Decl. Ex. E, 10/1/91 Amendment, ('992) p. 23.)

The applicants repeatedly distinguished their invention in this manner from prior art during prosecution:

- "[t]he present invention affords the user greater access to and control over audio and video information than is possible in conventional systems. With the present invention, a user can

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[22] Acacia said this in support of its argument that claim 41 does not require the user to choose a premises remote from where he requests the information. In other words, Acacia argued that, even though applicants distinguished prior art on this basis, it was to distinguish claims such as claim 19, not claim 41, because claim 41 does not contain a "selected remote location" limitation.

> request audio and video information to be sent to a selected destination." (Benyacar Decl. Ex. B, '992 Prosecution History, Petition to Make Special, pg. 2.)

- "Further, in Monslow et al., the viewer-chosen program is transmitted to the television receiver of the requesting viewer. The requestor therefore does not have a choice of where the information that they request is sent." (*Id.* at 8.)
- "Although the system affords the viewer some control over accessing the material, it requires that a location designated by the viewer be wired with a dedicated cable. The Walter system further requires that the viewer be at that location for both ordering and viewing the audio/video material." (*Id.* at 9.)

The Court's prior Markman Order supports Round 3 defendants' construction. In its July 12, 2004 Markman Order (hereinafter "Markman I", Benyacar Decl. Ex. L), the Court defined the term "remote locations" to mean "positions or sites distant in space from some identified place or places." (p. 7.) In the context of claims 1 and 41, the Court held that "the term 'remote locations' means 'positions or sites distant in space from the transmission system.'" (*Id.*) The Court did not at that time construe the term for purposes of claims 19 and 47. It observed, however, that, unlike claims 1 and 41 which make no mention of a "user," "claims 19 and 47 contain additional limitations that the remote location be specified by the user of the system." (*Id.* at 4.) Consistent with the Court's 2004 decision, the term "selected remote location" in claims 19 and 47, which include references to user requests, should mean a position or site distant in space from *both* the transmission system and the user.

Acacia argues that the specification "never states that the user must only request that the information be sent to" a location different from the user's current location. (Acacia Br. p. 27.) This is a non-sequitur. The fact that a patentee discloses several different methods does not preclude him from claiming a specific one. Therefore, even if Acacia is correct that the specification discloses transmitting information to the same location from which the user makes the request (which it does not), that is not what applicants claimed.[23]

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[23] Acacia argues the specification discloses that a user can use a terminal to request and receive information at the same location. (Acacia Br. p. 26.) The passage

B. The User's Request Identifies the Selected Remote Location

The claims require "sending a request, by the user" to transmit information to "a remote location selected by the user." This language and the specification supports our construction that the request must include an identification of the specific remote location.

Every embodiment of the invention disclosed in the specification teaches that the user selects the location where the information is to be sent at the time the request is made. Two different ordering scenarios are depicted in Fig. 3 and Fig. 4, and both require this:

- "As shown in Figure 3 (Sheet 7 of 12), after confirming his or her selection, the user 'inputs a desired delivery time and delivery location.'" (Col. 14: 32-33.)
- "After the desired item is found, the user selects the item for transmission at a specific time and location." (Col. 15: 20-22, describing Fig. 4.)

Again, in its claim construction briefing in the initial action against Round 1 defendants, Acacia admitted what it now denies: that the user request for information includes the selection of the remote location. Acacia stated:

> Defendants argue that, in claim 19, the term "remote locations" used in the preamble, provides antecedent basis for the phrase "one of the remote locations selected by a user" in the "sending a request . . ." claim step. Defendants focus on the portion of this phrase "the remote locations," but ignore the portion "selected by the user." *The phrase "one of the remote locations selected by a user" is part of the step of "sending a request. . ."* Therefore the antecedent basis for the phrase "selected by the user" is found in the phrase "sending a request," not in the phrase "remote locations," because *the identity of the location selected by the user is in the request which is sent by the user.*"

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relied on by Acacia describes a "terminal interface method" to request information, not the use of a terminal to receive that information. (See col. 14:64-15:2) This method permits users to make requests using terminals that communicate with reception systems that have "specialized interfaces" used to communicate with the terminals. (See "user/computer interface" 207 in Figure 6.) Although the specification does not explain how these terminals and interfaces work, the specification states that they are used to select a location to which the information will be sent as shown in Figure 4. (See also 15:20-22: "the user selects the item for transmission at a specific time and location...")

(Benyacar Decl., Ex. K, p. 7 n. 3, emphasis added.) In the same brief, Acacia similarly recognized that:

> "In claims 19 and 47, the inventors intended to claim a method and system which was limited so that the request sent by the user would identify a reception system at a selected remote location and the information would be transmitted to this location." (*Id.* at 8.)[24]

C. Each Of The Remote Locations Has A Receiving System

The claims require that the user request identify "one of the receiving systems at one of the remote locations selected by the user." Acacia argues nevertheless that every one of the remote locations from which the user chooses the "selected remote location" need not have a receiving system to receive the information. (Acacia Br. p. 29.) This makes no sense. The concept of "selection" means that the user can choose from among multiple remote locations that are equipped to receive the transmission.[25] If a location does not have the ability to receive the transmission (because it lacks a receiving system), the user cannot select it as the location to which the information will be sent. The specification makes this clear: "A still further object of the present invention is to provide a picture and sound transmission system wherein the selected audio/video material is sent . . . *to any location chosen by the user that has a specified receiver.*" (Col. 1:67 - 2:4.)

D. Remote "Locations" Means Remote "Premises"

The claims require user selection of a "remote location" which will receive information from the transmission system. The word "location," *when used in the context of a user selecting a remote location*, means a "premises." Applicants made this abundantly clear during prosecution.

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[24] Acacia now argues that the user's selection cannot be in the request because "selected" is past tense, meaning that "[i]f anything, the claim states that the remote location is already selected when the request is made." (Acacia Br. p. 28.) Even if Acacia was correct, the claim still requires the user to select the particular remote location (such as by typing it into a computer terminal) before the request containing that selection is sent to the transmission system.

[25] Acacia does not dispute that the user must have more than one remote location to select from. (Acacia Br. p. 25.)

They argued during the prosecution of U.S. Patent No. 6,002,720, which was filed as one of a series of continuations from the ’992 patent and shares its specification, that when the specification referred to user selection of a remote location, location meant a “premises” and not “merely space in a particular structure”:

> [T]he claimed invention includes a transmission system that transmits information to any premises chosen by the user that has a specified receiver. *See* Appl. No. 08/630,590 (page 4, ll.4-5.) In order to place an order, the user enters a customer ID code and makes a selection by entering a corresponding identification code for the desired item. Upon receiving confirmation, the user selects the desired delivery time and *destination*. *Id.* at page 30, line 15 - page 31, line 10 (*See also* page 31, line 14; page 32, line 26, page 33, line 6). That destination is not limited to a pre-determined user premises. . . .
>
> *Notably, Applicants have used the term “location” to refer to a premises rather than merely space in a particular structure*. For example, Applicants distinguished U.S. Patent No. 4,506,387, issued to *Walter* (“the *Walter* patent”) [in the specification] based upon the fact that the system disclosed in the *Walter* patent requires a dedicated cable wired to the viewer’s *premises* and that the viewer be at that *location* for both ordering and viewing the audio/video material. *Id.* at page 2, ll. 14-21.[26]

(Reply and Amendment Under 37 C.F.R. § 1.111, June 7, 1999, p. 7, Benyacar Decl., Ex. J.)

Acacia argues that the Court previously refused to rely on this prosecution history to define the term “location.” (Acacia Br. p. 8.) The Court’s prior ruling, however, addressed a different claim term. Round 1 defendants previously relied on the above-quoted portions of the ’720 prosecution history to construe “a transmission system at a first location,” even though the passages from the ’720 prosecution history refer to the location where the transmission is received, not the location of the transmission system. The Court based its decision on this difference: “The term location is being applied in different context in that particular situation.” (Markman I, Benyacar Decl. Ex. L at p. 30 n. 22.) Here, Round 3 defendants rely on the quoted portion of the ’720 prosecution history to confirm their construction of “location” in the context of the location at which the transmission is received. This is the very same context in which applicants made their representations about the specification, quoted above, during prosecution of the ’720 patent. It is therefore entirely appropriate for the Court, in construing the ’992 patent, to rely on these statements made during prosecution of the ’720 patent. *See Microsoft Corp. v. Multi-Tech. Sys., Inc.*, 357 F.3d 1340, 1349-50 (Fed. Cir. 2004) (“[a]ny statements of the patentee in the prosecution of a related application as to the scope of the invention would be relevant to claim construction.”).

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[26] The language at “Appl. No. 08/630,590, page 4, ll.4-5” appears in the ’992 patent at col. 2, lines 3-4 which is quoted above. The language at “page 30, line 15-page 31 line 10” of the 08/630,590 application appears at col. 14, lines 14-40 of the ’992 patent. The language at “page 2, ll.14-21” of the 08/630,590 application appears at col. 1, lines 24-32 of the ’992 patent.

E. Acacia Attempts To Cover What The Specification Calls Prior Art

Acacia’s infringement contentions demonstrate the absurdity of its construction. As the Federal Circuit has held, courts should consider the infringement contentions that motivate a party’s claim constructions as context for construing the claims. *Lava Trading, Inc. v. Sonic Trading Mgmt.*, 2006 U.S. App. LEXIS 9708 at *3-4 (Fed. Cir. April 19, 2006) (“While a trial court should certainly not prejudice the ultimate infringement analysis by construing claims with an aim to include or exclude an accused process, knowledge of that product or process provides meaningful context for the first step of the infringement analysis, claim construction.”) Acacia asserts that Round 3 defendants would satisfy the “selected remote location” limitation under its construction because their cable subscribers could unplug a cable set-top box from the wall, carry it into another room, plug it into the wall and order a movie. By plugging the set-top box into the wall in the other room, Acacia asserts, the subscriber has selected a different remote location:

> Using their set top boxes, Time Warner subscribers transmit requests to Time Warner head ends identifying video on demand (VOD) programs to be sent from the Time Warner head end to one of the subscribers’ set top boxes (receiving system) at their home. Time Warner subscribers may have more than one outlet in their home for connecting a set top box to the cable network, each outlet being in a different remote location (*e.g.*, living room, bedroom). By selecting a particular outlet for a set top box within their home, the Time Warner subscriber has selected a location (e.g., living room), which is remote from the transmission system.

(Benyacar Decl. Ex. M, Plaintiff's Disclosure of Asserted Claims and Preliminary Infringement Contentions to TWC p. 10).[27] Clearly that is not the invention of the Yurt patents. Under this reading of "selected remote location," none of the distinctions from the prior art that Acacia relied upon in the specification and during prosecution of the '992 patent based on the user's ability to select a remote location would exist. In addition, it is clear that Acacia is now attempting to cover exactly what it told the Patent Office was not its invention during prosecution of the '720 patent. Acacia's tortured construction is a misguided attempt to salvage its infringement argument.

POINT IV (JCC # 6)

"PLAYING BACK . . . AT A TIME REQUESTED BY THE USER" ('992 patent, claim 19; '275 patent, claims 2 and 5)

Round 3 Defendants' Proposed Construction

> The request by the user to the transmission system "for at least a part of the stored information" must include a specific time supplied by the user specifying when playback is desired. (Systems which permit users only to request "play" for immediate playback do not satisfy this limitation.)
>
> "Playback" and "playing back" refer to the process of sending uncompressed signals to a device, such as an audio amplifier and/or television, on which video information can be displayed and/or audio information heard. These terms are construed similarly in other claims of the '992 and '275 patents.

Argument

A. "At A Time Requested By The User"

The plain language of the phrase "at a time requested by the user" – as distinct from "*when*ever requested by the user" – reflects that the user specifies, in advance, the time when the information is to be played. Simply pushing a "play" button for immediate playback of the information is not "requesting" a "time."

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[27] Acacia also argues that defendants infringe even if the user does not move the set top box because the user *could* move it. Not moving it, under Acacia's logic, also constitutes selecting the remote location.

As discussed above, the claims cover making a user request from a location different from the location where he will view or listen to the information. It would make no sense for the user to request that the information be played back at the exact time the request is made because the user would not be at the selected location to view or listen to the information. Accordingly, the claims couple the limitation "selected remote location" with the requirement that the user select a time when the request for information is made.

The specification supports the Round 3 defendants' construction. It describes the invention as a system that permits the user to specify a future playback time as part of the user's request for information. For example, the specification states:

- "After the desired item is found, the user selects the item for transmission at a specific time and location." (Col. 15:20-22.)
- "The requested information is then played back to the reception system of the user at the time requested by the user." (Col. 19:34-36.)

(*See also* col. 5:11-14; col. 12:24-27; Figure 3.)

The specification explains that the future playback time is something that the user inputs into the system. It states that the user "*inputs* a desired delivery time and location" (Col. 14:32-33), "*enters* the playback time and destination" (Col. 14:39-40) or "*indicates* the delivery time and destination" (Col. 14:60-61). Thus the user must be doing more than pressing a play button when he or she wants to experience the information.

Acacia concedes that the specification teaches "that the user's initial request [] include[s] a time specifying when playback is desired." (Acacia Br. p. 22.) It asserts, however, that this is only one embodiment, and that Round 3 defendants ignore another embodiment in which a user requests a future time for playback simply by pressing a play button after the information has been stored in the receiving system. (Acacia Br. p. 21.) Even if the specification did disclose this alternative embodiment, that is not the embodiment claimed, which requires the user to specify a time. In fact, however, the specification does not disclose the embodiment Acacia describes. As demonstrated by the same portions of the specification Acacia cites, unless the user indicates when requesting the information that she wants to experience the information at a later time, the storage device at the receiving system will not record the information at all:

> In the reception system of the present invention, the user may want to play back the requested item from the source material library 111 at a time later than when initially requested. *If that is the case, the compressed formatted data blocks* from receiver format converter 202 *are stored in storage 203*. Storage 203 allows for temporary storage of the requested item until playback is requested. (18:14-21.)

The only way that a user can indicate that she wants "to play back the requested item ... at a time later than when initially requested" is for the user to include a time in her request. The specification teaches no other way for the user to inform the system that she desires play back "at a time later than when initially requested." (See Fig. 3.)

Therefore, if (and only if) the user selects a future time for playback when she requests the information, the information will be stored in the receiving system and played back to the user at the time contained in the initial request. If the user does not provide a future time when requesting the information, the information never gets stored in the receiving system. The embodiment Acacia describes in its brief, where the requested information gets stored in the receiving system even if the user does not supply a future viewing time with the request, is not described in the specification.

B. "Playing Back"[28]

The specification makes clear that the term "playing back" is used in the patents to refer to the transmission of the requested information, in uncompressed format, to a device, such as an audio amplifier or television, so that the information can be viewed or heard:[29]

- As depicted in Fig. 6:

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[28] Acacia refused the Round 3 defendant's request to include "playback" in this section of the Joint Claim Chart. We nonetheless addresses the term here, where it first appears in the claims.

[29] Acacia appears to agree that "playing back" involves sending *uncompressed* signals because it includes a "decompressor" in its definition of "playback means" that decompresses the information before sending it to the device that enables the signals to be seen or heard. (Acacia Br. p. 79-81.)

> "When playback is requested, the compressed formatted data blocks are sent to data formatter **204**. Data formatter **204** processes the compressed formatted data blocks and distinguishes audio information from video information. The separated audio and video information are respectively decompressed by audio decompressor **209** and video decompressor **208**. The decompressed video data is then sent simultaneously to converter **206** including digital video output converter **211** and analog video output converter **213**. The decompressed audio data is sent simultaneously to digital audio output converter **212** and analog audio output converter **214**. The outputs from converters **211-214** are produced in real time. The real time output signals are output to a playback system such as a TV or audio amplifier." (Col. 18:12-37.)

- "The present invention comprises . . . decompressing means, coupled to the receiver format conversion means, for decompressing the compressed formatted information; and output data conversion means, coupled to the decompressing means for playing back the decompressed information in real time." (Col. 2:62 - 3:14.)

- "Copy protected programs, when decompressed and played back, would have a copy protection technique applied to the analog and digital output signals." (Col. 5:46-48.)

Claim 25 of the '992 patent further supports Round 3 defendants' definition. It requires "data conversion means, coupled to the decompressing means, for playing back the decompressed copy of the data at a time specified by the user."

POINT V (JCC # 9, #47)

"SENDING AT LEAST A PORTION OF THE STORED INFORMATION FROM THE TRANSMISSION SYSTEM" ('992 patent, claim 19; '275 patent claims 2 and 5)

Round 3 Defendants' Proposed Construction

> In response to the user request, at least a portion of the information from items in compressed data form that was stored in the transmission system must be retrieved from the device on which it was stored, then sent.

Argument

The claim language is clear that the following is required:

- the "information" is "stored";
- the "storage" is in the "transmission system";

- at least a portion of the stored information is “sen[t].”

In addition, this “sending at least a portion ...” step in each of the claims immediately follows the step of “sending a request, by a user... for at least a part of the stored information ...” Thus, the information must be retrieved in response to this user request and sent.

“The stored information” in the claimed step of “sending at least a portion of the stored information from the transmission system” refers to the information that was stored, on a storage device, in the step of “storing, in the transmission system, information from items in a compressed data form. . .”[30] Because the claims require that “the stored information” be sent, the claims require sending the information from the device in the transmission system on which it was stored. It is settled law that the use of the word “the,” as in “the stored information,” refers to the previous instance of the thing described. M.P.E.P. 2173.05 (e); *NTP*, 418 F.3d at 1306.

POINT VI (JCC #’s 10 and 49)

THE ORDER OF STEPS (’992 claim 19 and ’275 claims 2, 5)

Round 3 Defendants’ Proposed Construction

The steps of claim 19 of the ’992 patent and of claim 2 and 5 of the ’275 patent must be performed in the following order:

1. “storing information in the transmission system, information from items in a compressed data form, the information including an identification code and being placed into ordered data blocks”;
2. “sending a request, by the user to the transmission system . . .”;
3. “sending at least a portion of the stored information . . .”;
4. “receiving the sent information . . .”;
5. “storing a complete copy of the received information . . .”; and

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[30] While Acacia complains that “[n]othing in these claims state ... that the information is stored on a storage device,” (Acacia Br. p. 30), the existence of some type of storage device is the necessary predicate to any step of storing.

6. "playing back the stored copy . . ."

In addition, as part of the first step of storing information, the act of placing information including an identification code into ordered data blocks must occur prior to placing the information into a compressed data form.

Argument

A. The Order Of The Steps Within Step 1

Point II.A, above, sets forth Round 3 defendants' argument for the order of the steps within step 1.

B. The Order Of Steps 1-6

Acacia agrees with Round 3 defendants that steps 1 through 6 should be performed in the order recited in the claims.

POINT VII (JCC # 11)

"WHEREIN THE INFORMATION IN THE ITEMS INCLUDES ANALOG AND DIGITAL SIGNALS (claims 20 and 48)

"ORDERING THE CONVERTED ANALOG SIGNALS AND THE FORMATTED DIGITAL SIGNALS INTO A SEQUENCE OF ADDRESSABLE DATA BLOCKS" (claim 20)

Round 3 Defendants' Proposed Construction

The information obtained from the plurality of physical items must include information in both analog and digital form, from which one set of sequenced and addressable data blocks must be formed.

Argument

The Round 3 defendants' reading of the claim terms is mandated by their plain language. Claim 20 depends from claim 19. As described in Point I above, the preamble of claim 19 references user-identified physical "items. . . containing information." Claim 20 describes a particular way to perform the distribution method of claim 19 wherein those physical items includes "analog and digital signals."[31]

The language of claim 20 also requires that the analog and digital signals be "order[ed]" into "a sequence of addressable data blocks." In other words, the analog and digital signals have to be integrated into a single "sequence of addressable data blocks." Contrary to Acacia's *ipse dixit*, the fact that the information being stored comes from a plurality of "items" does not mean that the information may be in multiple sequences of data blocks.[32] There is no provision in the claim for more than one sequence. If information is divided into groups, and the addressable data blocks in each group are not sequenced with respect to any other group, it would make no sense to describe the entirety of the information as being in sequence. In addition, there is no disclosure of dividing information retrieved from the source material library into such groups, sequencing every group independently of every other group, and then compressing all of the groups together, as would be required by claim 20 if Acacia's construction of this claim term is correct.[33]

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[31] The same applies to the language in the preamble of dependent claim 48 which depends from claim 47. Claim 48 specifies that the "items containing information," described in the preamble of claim 47, "include analog and digital signals."

[32] The fact that courts sometimes construe "a" to mean one or more is irrelevant when, as in the present case, the claim language makes clear that "ordered data blocks" is part of a singular grouping of information referred to in the claims as "the information" and "the stored information." *See Abtox, Inc. v. Exitron Corp.*, 122 F.3d 1019, 1023-24 (Fed. Cir. 1997) (construing "a metallic gas-confining chamber" to be a single chamber because claim repeatedly refers to "said chamber").

[33] Because the Court has already construed "sequence of addressable data blocks," the Round 3 defendants will address this term at the August 11 *Markman* hearing.

POINT VIII (JCC # 18)

"COMPRISING THE STEPS, PERFORMED BY A TRANSMISSION SYSTEM, OF" (claims 41)

"COMPRISES THE STEPS, PERFORMED BY A TRANSMISSION SYSTEM" (claim 20)

Round 3 Defendants' Proposed Construction

> All of the steps recited in claims 41 and 20 must be performed automatically by a transmission system (not by a human).

Argument

A. The Preamble Is A Claim Limitation

1. The Applicants Amended the Preamble to Overcome Prior Art Rejections

As discussed in Point I (A)(1)(c) above, when an applicant amends a preamble during prosecution to overcome a prior art rejection, the preamble is a limitation. *Catalina Marketing*, 289 F.3d at 808; *Invitrogen Corp. v. Biocrest Manufacturing, L.P.*, 327 F.3d 1364, 1370 (Fed. Cir. 2003) (preamble acts as a limitation because "[i]n response to the Examiner's rejection, the applicants for the 797 patent amended the claims to include the 'improved competence'"). Here, the requirement in the preambles of claims 41 and 20 that all of the steps be performed "by a transmission system" was added by the applicants during prosecution, at the examiner's direction, to overcome prior art rejections. The examiner rejected claims 41-46 "under 35 U.S.C. § 103 as being unpatentable over Abraham (806) in view of Ulicki." (Benyacar Decl. Ex. C, '992, December 10, 1991 Office Action.) The examiner then noted in an interview summary that he discussed the Abraham '806 patent with applicants and provided "comments about claims," including claim 41, and that he would "reconsider the allowability of the claims upon the submission of the amendments." (Benyacar Decl. Ex. D, '992, December 20, 1991 Interview Summary.)

Applicants subsequently made *a single amendment* to claim 41. The amendment changed the preamble so that it required all of the steps be "performed by a transmission system." A similar amendment was made to claim 20 (application claim 19) (Benyacar Decl. Ex. F, '992, December 26, 1991 Response, pp. 3 and 5.) Applicants had no need to argue for allowance because the examiner proposed the amendment needed to overcome the prior art. They simply noted that these amendments "reflect[] the suggestions made by the Examiner." Because of these amendments to the two preambles, the examiner then allowed the claims. (Benyacar Decl. Ex. G, '992, February 5, 1992 Notice of Allowability.) Thus, it is clear that applicants complied with the examiner's requirement that they amend the preamble to include "performed by a transmission system" to overcome the cited prior art. The language added to the preamble must therefore be deemed limiting.

2. "Performed by a Transmission System" is an Important Aspect of the Invention

As also discussed in Point I (A)(1)(b) above, a preamble will be limiting if the specification indicates that the structure or steps contained in the preamble are important. *Catalina Marketing*, 289 F.3d at 808; *Gen. Elec. Co. v. Nintendo Co., Ltd.*, 179 F.3d 1350, 1361-62 (Fed. Cir. 1999) ("The effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.") In this case, one cannot read the specification of the Yurt patents without understanding that the "transmission system" and the "receiving system" *is* the alleged invention. The title of the '992 patent alone reveals this: "Audio and Video Transmission and Receiving System." The only disclosure in the specification of how to perform the steps in claims 41 and 20 is by using a transmission system.

Pursuant to Acacia's construction of these claims, though, none of the steps in claim 41 need be performed by a transmission system. All of the steps of claims 41 and 20, according to Acacia, could be performed by humans, including the steps of "formatting data into a sequence of addressable data blocks" and "compressing the formatted and sequenced data." There is no support for this in the specification, which only teaches performance of the method by a transmission system.

The specification is directed to using a "transmission and receiving system for providing information to remote locations." ('992, col. 2:25-29; Benyacar Decl. Ex. B, '992, Petition to Make Special, p. 2: "The entire system includes a transmission system and a reception system.") All of the figures in the Yurt patents depict either the transmission system or the reception system, or methods of using these systems. Figure 7 of the specification, which is the figure that depicts the method of sending information from the transmission system to the reception system (referred to in the preambles of claims 41 and 20), describes steps recited in the claim as being performed by components of the transmission system. For example:

- the claimed assigning of the unique identification code is described as being performed by the identification encoder of the transmission system (18:63-68);
- the claimed placing the information into a predetermined format is described as being performed by the converter 113 of the transmission system (18:65-19:2);
- the claimed "placing the formatted data into a sequence of addressable data blocks" is described as being performed by the ordering means of the transmission system (19:2-4);
- the claimed "compressing" is described as being performed by the data compressor of the transmission system (19:5-7); and
- the claimed "storing, as a file" is described as occurring in the compressed data library of the transmission system (19:11-17).

Thus, unlike the invention described in *Vaupel,* relied upon by Acacia, the '992 patent describes a transmission system in nearly every column and illustrates a transmission system in eight of its figures. *See Vaupel Textilmaschinen KG v. Meccanica Euro Italia S.P.A.*, 944 F.2d 870, 880 (Fed. Cir. 1991) (loom parts mentioned in preamble found non-limiting were "not illustrated in any of the figures of the '650 patent or otherwise described in the specification"). The entire specification is directed toward using the transmission system to process and provide information to remote locations - not to processing and sending information by human action. *See Gen. Elec.*, 179 F.3d at 1361-62 (preamble limiting because the "specification makes clear that the inventors were working on the particular problem of displaying binary data on a raster scan display device and not general improvements to all display systems"); *see also In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994) (preamble with "computer comprising . . ." in a claim that did not use the term "computer" in the body nevertheless deemed limiting to properly define the invention disclosed in a patent entitled "Portable Computer.")[34]

Finally, "transmission system" is a limitation in the body of other claims of the '992 patent (see, for example, independent claims 19, 25, 47 and 54). This is a further indication that "transmission system" is important to the invention, and that the claim 41 preamble is therefore a limitation. *Rohm & Haas*, 127 F.3d at 1091 n. 1.

3. Unless All of the Steps must be "Performed by a Transmission System," "Transmission System" Does Not Provide a Reference Point for "Remote Location"

Acacia argues that the language in the preambles of claims 41 and 20 calling for all of the steps to be performed "by a transmission system" is not limiting because "transmission system" is in the preamble only to provide a "reference point" for "remote location." (Acacia Br. p. 48-49.) Acacia is correct that "transmission system" provides a reference point for "remote location." The remote location must be a location remote from the transmission system. (Benyacar Decl. Ex. L, Markman I p. 7:20-24.) That "reference point," though, is the particular transmission system that performs all of the steps of claim 41. The "remote location" must be remote from *that* transmission system. If not for the limitation that all of the steps be performed by the transmission system, "transmission system" could not be a reference point because there would be no way to tell which "transmission system" the "remote location" had to be remote from.

For example, a location such as a home may have many systems that are used to store and send/receive information to and from the home, such as a Blackberry or a computer connected to the Internet. Pursuant to the Court's previous construction of "transmission system" to mean "an assembly of elements, hardware and software, that function together to convert items of information for storage in a computer and subsequent transmission to a reception system" (Benyacar Decl. Ex. L,

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[34] To the extent that claims, such as claim 19 of the '992, are not construed to require steps performed by a transmission or reception system, those claims are invalid for lack of written description. The Round 3 defendants will address the issue at the appropriate time.

Markman I p. 28.),[35] the Blackberry and the computer are transmission systems. The home is not remote from those transmission systems. By specifying that all of the steps of claim 41 must be performed by the transmission system, however, the claim excludes transmission systems such as a Blackberry and a computer from being the transmission system that the home must be remote from. A "remote location" must only be remote from the transmission system which performs all of the steps of claim 41. If not for the "performed by the transmission system" limitation, the claims would be ambiguous as to which transmission system the "remote location" had to be remote from, rendering the claims indefinite.[36]

B. "Performed By A Transmission System" Means A Human Does Not Perform The Steps

Acacia argues that the provision in Round 3 defendants' construction that the steps of claims 41 and 20 must be performed "automatically by a transmission system (not by a human)" is incorrect because this requirement "is not stated in either of these claims." (Acacia Br. p. 50.) Acacia appears to be seeking reargument. The Court previously rejected Acacia's argument that a component of a "transmission system" can be a human. After having been through two previous rounds of claim construction, Acacia should not be permitted a third bite at this apple.

Acacia previously argued that "transmission system" includes "people" because the specification describes the transmission system as including "humans acting as system operators." Thus, Acacia asked the Court to adopt the following construction of transmission system: "an assembly of elements, such as people, machines and/or methods, capable of functioning together to transmit signals." (Benyacar Decl. Ex. L, Markman I, p. 27:14-24.) The Court rejected this construction and limited "transmission system" to "an assembly of elements, hardware and software . . . ," intentionally excluding people from the construction. (Benyacar Decl. Ex. L, Markman I, p. 28:11-14.)[37] Similarly, the Court held that there was no disclosure that the "identification encoding means," a component of the disclosed transmission system, could be a human. (*Id*. pp.15-16.)[38]

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[35] The Court construed "reception system" as "an assembly of elements, hardware and software, capable of functioning together to receive items of information." *Id.*

[36] The fact that the applicants chose to amend the preamble by requiring all of the steps to be performed by a transmission system also demonstrates that they did not intend the preamble to act solely as a reference point for "transmission system." If they had so intended, the preamble could have recited "A method of transmitting information from a transmission system to a reception system." (This would not have fixed any of the other problems described above stemming from using an unspecified transmission system as a reference point for "remote location," however.)

In any event, Acacia has not sought, and is not entitled to seek, reconsideration of the Court's prior construction of "transmission system." Therefore, Round 3 defendants will not address in this brief all of the reasons why the Court was correct not to include "human" in its construction.[39] We will briefly explain, however, why Acacia's reliance on the specification's reference to "system operator" is misplaced.

The term "system operator" by itself does not necessarily mean a human. It's meaning must be derived from the context in which it is used. A system operator can be an organization that operates a system. For example, the Round 3 defendants Time Warner Cable Inc. and CSC Holdings,

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[37] Applicants themselves relied on the fact that "transmission systems" do not include humans to distinguish the prior art during prosecution. Applicants distinguished pending claim 1 (which applicants said claim 41 was based on) from the Fenwick 4,947,244 patent. Applicants argued that "[b]ecause the system is *manually controlled*, Fenwick et al. does not disclose a transmission system including an identification encoding means . . . as required in independent claim 1." (Benyacar Decl. Ex. B, '992, Petition to Make Special, p. 11; emphasis added.) Accordingly, Acacia cannot now be heard to argue that claims requiring transmission systems can include human (manual) action.

[38] The Court also stated that "[b]ecause the specification of the '992 patent, does not disclose a human being as a corresponding structure for the identification encoding means, the Court does not reach the legal issue of whether a human being can even be a corresponding structure." The Federal Circuit has ruled that a human being cannot be a corresponding structure. *Default Proof Credit Card Sys. v. Home Depot U.S.A., Inc.*, 412 F.3d 1291, 1300 (Fed. Cir. 2005) ("a human being cannot constitute a 'means'").

[39] If Acacia is for any reason granted reconsideration, the Round 3 defendants will ask for the opportunity to brief these issues.

Inc. are among a handful of large cable television companies that operate multiple cable systems. Therefore, these companies are known as "Multiple System Operators," or "MSOs."[40] Obviously, Time Warner Cable Inc. and CSC Holdings, Inc. are not humans.

Here, the context is clear. Every one of the references to a "system operator" cited by Acacia relates to "storage encoding." "Storage encoding [is] performed by [the] identification encoder." (Col. 6:39-40.) According to the Court's prior ruling and applicants' arguments to distinguish prior art during prosecution of the '992 patent, (*see* Point VIII(B)¶2, *supra*), the identification encoder does not include a human.[41] Furthermore, most of the functions the specification describes a system operator as performing would not normally be performed by a human. For example, a human cannot assign a "unique address code" (Col. 10:58-61) because addresses in memory are assigned by computers. In addition, a human would not "index starting frame numbers." (Col. 8:42-45.)

Even if the disclosure had taught that the system operator must be a human, Acacia's argument that transmission systems can be comprised of humans would still fail. The fact that a human can operate a transmission system, or any system for that matter, does not mean that the system includes that human. For example, although humans set the temperature on home central heating systems, central heating systems do not include humans.

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[40] See, for example, definitions of "MSO" at http://www.imcc-online.org/GLOSSARIES/glossary.htm; http://computing-dictionary.thefreedictionary.com/MSO; and http://www.pcmag.com/encyclopedia_term/0,2542,t=MSO&i=47361,00.asp

[41] Even Acacia's own experts have opined that the identification encoder is hardware and software, not a human. *Declaration of Peter Alexander in Support of Acacia's Opposition to Motion for Summary Judgment*, ¶ 11. ("It is my opinion that one of skill in the art would have understood the claim term 'identification encoder' to mean 'a device or computer program to create unique codes...'") *Declaration of S. Merril Weiss in Support of Acacia's Opposition to Motion for Summary Judgment*, ¶ 62. ("[One of ordinary skill in the art] would have understood [identification encoder] to be a computer program or routine, running on either standard or specialized hardware...")

Finally, none of the functions the specification describes as being performed by a "system operator" need to be performed to satisfy the limitations of claim 41 or claim 20. Nor is there any disclosure that the steps that *are* recited in these claims must or even can be performed by a system operator.

In actuality, Acacia's argument that the references in the specification to a "system operator" means that transmission systems can comprise humans is just another way of arguing that the preambles of claims 41 and 20 are not limitations. If "performed by a transmission system" means the steps can be performed by a human, then the phrase would have no meaning, and would not limit the claims. For all of the reasons discussed above, this cannot be the proper construction.

POINT IX (JCC # 12)

THE ORDER OF THE STEPS (claim 20)

Round 3 Defendants' Proposed Construction

> The steps of claim 20 of the '992 patent must be performed as part of the first step of storing in claim 19. In addition, the steps of claim 20 must be performed in the order in which these steps are recited in the claim, namely:
>
> 1. "converting the analog signals of the information . . .";
> 2. "formatting the digital signals of the information";
> 3. "ordering the converted analog signals and the formatted digital signals . . .";
> 4. compressing the ordered information."
>
> Defendants disagree with Acacia's statement that there is no limitation that any step of claim 20 begins and occurs only after a prior step or steps have been completed.

Argument

A. The Order of the Steps

Acacia agrees that the steps of claim 20 must be performed in the order recited in the claim and as reproduced above. (See JCC #12.)

B. The Steps Must Be Performed One At A Time

Claim 20 requires the performance of a series of processing steps, in order, on information originally retrieved from items. As is evident from reading the claim steps reproduced above, the third and fourth steps require that the processing be performed on the product resulting from the processing of the immediately prior step. The final step, for example, requires "compressing the ordered information." "[T]he ordered information," however, does not exist until completion of the prior step which orders the information.

Without even attempting to explain the meaning of this claim language, Acacia asserts that claim 20 is broad enough to cover the performance any step prior to the completion of the preceding step, so long as no step begins before the preceding step has begun. (See JCC #12.) As explained in detail in Point XV(A), this contradicts the plain language of the claim and the case law.

POINT X (JCC # 13)

THE ORDER OF THE STEPS (claim 21)

Round 3 Defendants' Proposed Construction

> The additional step of claim 21 is a substep of the first step of storing of claim 19. The substep of claim 21 must be performed after the steps set forth in the first step of storing in claim 19.

Argument

Acacia agrees that "[t]he step of claim 21 is a substep of the first step of storing of claim 19." (*See* JCC # 13.) Acacia, however, argues that "the substep of claim 21 can be performed either before, after, or simultaneously with the first step of storing of claim 19." (Id.) Its argument ignores the claim language and the specification. The claimed substep cannot be performed before or simultaneously with the first storing step of claim 19 because there is no compressed information to store in "compressed audio and video libraries" until the first storing step of claim 19 is completed. The "information from items" is not placed into a compressed data form until the first storing step of claim 19 is completed. Moreover, the specification discloses placing the information into ordered data blocks and then compressing before storing in compressed data libraries. (*See, e.g.*, Fig. 7: "Sequence Data," "Compressing the Data," "Store as a File.")

POINT XI (JCC # 14)

"THE STEP OF STORING INCLUDES THE STEP OF STORING THE RECEIVED INFORMATION AT THE HEAD END OF A CABLE TELEVISION RECEPTION SYSTEM"(claim 23)

Round 3 Defendants' Proposed Construction

> There are two "storing" steps in claim 19, from which claim 23 depends. The "step of storing" recited in claim 23 refers to the second step of storing in claim 19 of "storing a complete copy of the received information in the receiving system at the selected remote location." Pursuant to claim 23, the head end is the "selected remote location."
>
> This claim term requires that when the user selects from among a plurality of (two or more) remote locations having receiving systems, the user selects that the requested information be sent to the head end of a cable television system for storage. The request by the user "for at least a part of the stored information" must include an identification of the head end to which the user wants the information sent.

Argument

Acacia agrees with Round 3 defendants that the referenced "step of storing" in claim 23 corresponds with the second "storing" step described in independent claim 19, which requires "storing a complete copy of the received information in the receiving system at the selected remote location." (Acacia Br. p. 41.) Claim 23 requires that this storing step "includes the step of storing the received information at the head end of a cable television system." Thus, the language of claims 19 and 23, taken together, requires that the head end of claim 23 be at the "remote location" selected by the user at which the stored copy is played back. In other words, claim 23 specifies that the "selected remote location" of the second storage step of claim 19 is the location of a cable head end.

Accordingly, all of the limitations associated with "selected remote location" in claim 19, as described above in Point III, must apply to the cable head end of claim 23. The cable head end must be among the plurality of remote locations from which the user selects, and it must be the location actually selected by the user. Furthermore, because claim 19 requires that an identification of the selected remote location be included in the user's request for information, claim 23 requires that the identification of the selected remote location be an identification of the selected cable head end.

Acacia argues that the head end of claim 23 is not the selected remote location of claim 19. According to Acacia, claim 23 adds an entirely new storing step to the claim requiring storage at the cable head end, unrelated to the second "storing" step of claim 19 that it limits. (Acacia Br. pp. 41-42.) Acacia's interpretation contradicts the plain language of the claim. "The step of storing" in claim 20 further defines the second step of storing in claim 19, it does not create a new storing step. In addition, the receiving system of claim 19 must receive the information that was sent in the claim 19 step of "sending at least a portion of the stored information from the transmission system *to the receiving system* at the selected remote location." Under Acacia's construction of claim 23, the receiving system would no longer receive the information that was sent as a result of the "sending at least a portion . . ." step. Instead, information would be sent to a cable head end that Acacia argues is not the receiving system, and the claim would be unclear as to how the receiving system ever received information or what information it received. This contradicts both the claim language and the specification.[42]

Finally, even if Acacia is correct that claim 23 introduces an entirely new storing step which is unrelated to the claim 19 storing step it modifies, Acacia is wrong that storing at the head end occurs before the storing at the receiving system. The claim language would mandate just the opposite. Acacia agrees that the steps of claim 19 must be performed in order. The two steps before the second storing step of claim 19 require:

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[42] Acacia relies on the specification in support of its construction. The specification, however, never discloses two receiving systems with storage capability in tandem, with one at the cable head end and another one at the user's home. In fact, the cable head end embodiment supports Round 3 defendants' construction, not Acacia's. (*See, e.g.*, Fig. 1f depicting cable head end as the only location for storing information received from a transmission system that is remote from the transmission system. The cable head end is also remote from the user who selects the location and experiences the play back.)

> *sending* at least a portion of the stored *information from the transmission system to the receiving system* at the selected remote location; and
>
> *receiving the sent information* by the receiving system at the selected remote location;

Thus, when the following step, the second step of storing of claim 19, refers to "storing a complete copy of *the received information* in the receiving system," the "received information" is the information that was sent by the transmission system. Under Acacia's construction, the "receiving system" would not store the "received information" from the transmission system, it would instead store information that it somehow obtained, directly or indirectly, from the head end. Moreover, Acacia's construction would require the following steps to occur in order:

> (1) the receiving system would first receive the information from the transmission system (in the claim 19 step of "*receiving the sent information* by the receiving system");
>
> (2) the cable head end would store the information (the step Acacia says is introduced by claim 23); and then
>
> (3) the receiving system would store the information;

Both the claim and the specification are silent as to how the information would jump back and forth between the receiving system and the cable head end in this manner.

Thus, if Acacia was correct that claim 23 introduces an additional storing step, in addition to the second storing step of claim 19, then the claim requires that the second storing step of claim 19 occur before storage at the head end.

POINT XII (JCC # 15)

THE ORDER OF THE STEPS (claim 23)

Round 3 Defendants' Proposed Construction

The additional step of claim 23 further defines the second step of storing of claim 19.

Argument

Acacia agrees that the "step of claim 23 is part of the second step of storing listed in claim 19." (JCC # 15.) This follows the plain language of the claim. However, Acacia also asserts the "step of claim 23 is performed before the second step of storing of claim 19." (*Id.*) For the reasons stated in the preceding Point, the Court should reject this contention and adopt Round 3 defendants' construction.

POINT XIII (JCC # 16, # 53)

"THE STEP OF STORING INCLUDES THE STEP OF STORING THE RECEIVED INFORMATION IN AN INTERMEDIATE STORAGE DEVICE" (claims 24)

"WHEREIN THE MEMORY MEANS IS AN INTERMEDIATE STORAGE DEVICE" (claim 53)

Round 3 Defendants' Proposed Construction

> There are two steps of storing in claims 19, from which claim 24 depends. "The step of storing" recited in claim 24 refers to the second step of storing in claim 19 of "storing a complete copy of the received information in the receiving system at the selected remote location." Pursuant to claim 24, the "intermediate storage device" is at the selected remote location.
>
> This claim term requires that when the user selects from among a plurality of (two or more) remote locations having receiving systems, the user selects that the requested information be sent to the "intermediate storage device" for storage. The request by the user "for at least a part of the stored information" must include an identification of the "intermediate storage device" to which the user wants the information sent.
>
> An "intermediate storage device" is a storage device at the remote location which is at a location other than where the user experiences the play back.

Argument

Claim 24 is similar to claim 23, in that both claims modify the second step of storage of claim 19. Instead of modifying this second step of storage by requiring that the selected remote location be a cable head end, however, claim 24 modifies it to require that the selected remote location include an "intermediate storage device." As reflected in our construction of claim 24, all of the limitations associated with "selected remote location" in claim 19 apply to the intermediate storage device of claim 24, for the same reasons described above with respect to the cable head end in claim 23.

The difference between a "cable head end" and an "intermediate storage device," however, is that "intermediate storage device" is not a known term of art and has no plain meaning.

There is no way to tell what it is about an intermediate storage device that makes it "intermediate." One must rely on the specification to find meaning for the "intermediate" qualifier. The only disclosure in the specification is that an "intermediate storage device" is device 200c in Fig. 1f (Col. 5:22-33), which is in a cable head end. (Col. 4:44-51.) The cable head end is remote from the location where the user experiences playback and is at a location intermediate between the transmission system and the user. (*See* Figs. 1e and 1f.) Therefore, the only construction for "intermediate storage device" that can be supported by the specification is a storage device at a location other than where the user experiences play back, although it need not be at a cable head end.[43]

Acacia argues, as it does with respect to claim 23, that claim 24 refers to an entirely new storing step having no relationship to the second step of storing in claim 19. (Acacia Br. p. 45.) Acacia is wrong for the reasons described with respect to claim 23. Acacia's construction that the "intermediate storage device" is a device "which is between the transmission system and the receiving system" also contradicts the plain language of the claim. The second step of storing in claim 19 requires storing "in the receiving system at the selected remote location." Claim 24 adds the further limitation that the storing occur "in the intermediate storage device." Therefore, the "intermediate storage device" must be *in* the receiving system at the selected remote location. Acacia's construction should be rejected because it incorrectly requires that the "intermediate storage device" be *outside* of the receiving system.

POINT XIV (JCC # 17)

THE ORDER OF THE STEPS (claim 24)

Round 3 Defendants' Proposed Construction

The additional step of claim 24 further defines the second step of storing of claim 19.

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[43] If this is not what "intermediate storage device" means, then there is no way to discern a meaning from the specification and the term is indefinite.

Argument

Acacia agrees that the "step of claim 24 is part of the second step of storing listed in claim 19." (JCC # 17.) This follows the plain language of the claim. However, Acacia also asserts the "step of claim 24 is performed before the second step of storing of claim 19." (Id.) For the reasons stated in the preceding three Points, the Court should reject this contention and adopt Round 3 defendants' construction.

POINT XV (JCC # 20)

"COMPRESSING THE FORMATTED AND SEQUENCED DATA BLOCKS" (claim 41)

Round 3 Defendants' Proposed Construction

> Compression begins and occurs only after the steps of "placing the retrieved information into a predetermined format as formatted data" and "placing the formatted data into a sequence of addressable data blocks" have been completed. The sequence of the formatted data blocks must be maintained by the compression process.

Argument

A. "Compressing The Formatted And Sequenced Data Blocks"

1. The Formatted Data must be Fully Sequenced before Compression

Claim 41 requires that the transmission system perform a series of processing steps, in order, on information originally retrieved from physical items.[44] Each step requires that the processing be performed on the product resulting from the processing of the immediately prior step. This is demonstrated by using italics to represent the product of the prior processing step and bold to represent the product of the current step:

- "placing *the retrieved information* into a predetermined format as **formatted data**"
- "placing *the formatted data* into a **sequence of addressable data blocks**"
- "**compressing** *the formatted and sequenced data blocks*"

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[44] Acacia agrees that the steps must be performed in order. (Acacia Br. pp. 56-57.)

- "**storing, as a file**, *the compressed, formatted, and sequenced data blocks . . .*"

Acacia argues that while these steps must be performed in order, one or more of these steps can be performed concurrently so long as each step begins before any subsequent steps begin. (Acacia Br. p. 57.) This cannot be squared with the claim language. Each of the steps is performed on the totality of the information as processed from the step before, not on portions of it. For example, "the formatted and sequenced data blocks" do not exist, and therefore cannot be compressed, prior to the completion of the second placing step that produces them.

In *Oak Tech., Inc v. Internat'l Trade Commiss'n*, 248 F.3d 1316, 1324 (Fed. Cir. 2001), the Federal Circuit rejected the exact argument that Acacia is now making. The claim at issue, in *Oak Tech.*, required "detecting errors" as a redundancy check on the data after "error detection and correction." The patentee argued that its claim was "broad enough to cover a situation in which the error detection operation commences before the error correction operation is completed." Like Claim 41 of the '992, the court found that the claim in *Oak Tech* recited steps that transformed data such that the second step performed its transformation "on the output" from the first step. *See id.* at 1325 ("According to the plain language of the claim, the 'assembled data' is processed by the 'error correction circuitry' and converted into 'corrected assembled data.' This 'corrected assembled data' is then processed by the 'cyclic redundancy checker,' which finally provides 'corrected data.'") Therefore, the court concluded, as this Court should, that "the plain language of the claim . . . explicitly describes a sequential process." *Id.; see also Techsearch L.L.C. v. Intel Corp.*, 286 F.3d 1360, 1376 (Fed. Cir. 2002) ("We conclude, however, that where, as in this case, the claim recites steps of a method, each dependent upon the other, we cannot interpret the limitations so loosely.")

Finally, the specification teaches a sequential process that takes place one step at a time. The following are just some examples:

- In the preferred embodiment, after identification encoding is performed by identification encoder 112, the retrieved information is placed into a predetermined format as formatted data by the converter 113. (Col. 6:58-62.)

- After the retrieved information is converted and formatted by the converter 113, the information may be time encoded by the time encoder 114. (Col. 7:64-66.)

- After compression processing by compressor 116, the compressed audio and video data is preferably formatted and placed into a single file by the compressed data storage means 117. (Col. 10:23-26.)

- After the data is processed into a file by the compressed data storage means 117, it is preferably stored in a compressed data library 118. (Col. 10:36-39.)

- After the information for the selected items is retrieved in step 412, the distribution method 400 of the present invention further comprises the step of processing the information for efficient transfer (step 413). (Col. 18:60-63.)

- After the information is processed for efficient transfer, in substeps 413a-e of step 413, the distribution method 400 of the present invention preferably includes the step of storing the processed information is stored in a compressed data library (step 414). (Col. 19:11-15.)

There is no written description for anything else.

B. Compression Must Maintain The Sequence Of The Data Blocks

Acacia argues that its claim is broad enough to cover a compression step that destroys the sequence of the data blocks which were created in the step immediately preceding the compression step. (Acacia Br. p. 53.) Again Acacia ignores the claim's plain language. The storing step requires that "the compressed, formatted, *and sequenced* data blocks . . ." be stored. If the compression step can un-sequence the data blocks, then "the sequenced data blocks" cannot be stored."[45] In addition, the claimed process would make no sense if the compression step destroyed the sequence that was created in the immediately preceding step.

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[45] While Acacia alleges that "nothing in the specification requires, or even states, that the sequence of formatted data blocks must be maintained during the compression process," (Acacia Br. p. 53), the plain language of the claim requires this, and nothing in the specification teaches that the sequence can be destroyed.

POINT XVI (JCC # 21)

"SENDING AT LEAST A PORTION OF THE FILE TO ONE OF THE REMOTE LOCATIONS" (claim 41)

Round 3 Defendants' Proposed Construction

> At least a portion of the file that was stored in the preceding step of claim 41 of "storing, as a file, the compressed, formatted and sequenced data blocks with the assigned unique identification code" is taken from the place where the information was stored in the preceding step of storing and is sent to one of the remote locations.

Argument

The plain language of the claim mandates that the "sending" step of claim 41 involves sending "at least a portion" of the "file" of "compressed formatted and sequenced data blocks" which is the subject of the immediately preceding "storing" step of claim 41. Because the claims clearly describe a sequential process (see preceding section), "at least a portion of the file" must be removed from the storage location of the "storing, as a file" step and sent directly "to one of the remote locations," for all of the reasons discussed above with respect to claim 19 (See Point V). Indeed, this is all that the specification discloses. (See Fig. 2a.)

POINT XVII (JCC # 22)

THE ORDER OF THE STEPS (claim 41)

Round 3 Defendants' Proposed Construction

> The steps of claim 41 of the '992 patent must be performed in the order in which these steps are recited in the claim:
>
> 1. "storing items having information in a source material library";
> 2. "retrieving the information . . .";
> 3. "assigning a unique identification code . . .";
> 4. "placing the retrieved information into a predetermined format as formatted data";
> 5. "placing the formatted data into a sequence of addressable data blocks";
> 6. "compressing the formatted and sequenced data";

7. “storing, as a file . . .”; and

8. “sending at least a portion of the file . . . .”

Argument

Acacia agrees that the steps of claim 41 “must be performed in the” order as claimed. (JCC # 22.) Without support in the claim or the specification, Acacia then asserts that any step of claim 41 can begin before the completion of a prior step. (Id.) For the reasons stated in Point XV (“compressing the formatted and sequenced data blocks”), the Court should reject this argument by Acacia and adopt Round 3 defendants’ construction.

POINT XVIII (JCC # 23)

THE ORDER OF THE STEPS (claim 42)

Round 3 Defendants’ Proposed Construction

> The additional steps of claim 42 further define the “placing the retrieved information” step of claim 41. In addition, the steps of claim 42 must be performed in the order in which these steps are recited in the claim:
>
> - “A/D converting analog signals . . .”;
> - “converting the series of digital data bytes . . . .”

Argument

Acacia agrees that “[t]he steps of claim 42 are part of the step of ‘placing the retrieved information’ of claim 41” and must be performed in order. (JCC #23.) Acacia, however, argues that “the steps of claim 42 are performed either before, after, or simultaneously with the” placing step of claim 41. (*Id.*) This cannot be the case. For example, the last step of claim 42 calls for “converting the series of digital data bytes into formatted data with a predetermined format.” This cannot happen either before or after the claim 41 step of “placing the retrieved information into a predetermined format as formatted data” as Acacia asserts, since the end result of both steps is the same “formatted data.”

POINT XIX (JCC # 24)

THE ORDER OF THE STEPS (claim 43)

Round 3 Defendants' Proposed Construction

> The additional steps of claim 43 further define the "placing the retrieved information" step of claim 41. In addition, the steps of claim 43 must be performed in the order in which these steps are recited in the claim:
>
> - "converting digital signals . . .";
> - "converting the predetermined voltage levels . . . ."

Argument

Acacia agrees that "[t]he steps of claim 43 are part of the step of 'placing the retrieved information' of claim 41" and must be performed in order. (JCC #24.) Acacia, however, argues that "the steps of claim 43 are performed either before, after, or simultaneously with the" placing step of claim 41. (*Id.*) This cannot be the case. For example, the last step of claim 43 calls for "converting the predetermined voltage levels into formatted data with a predetermined format." This cannot happen either before or after the claim 41 step of "placing the retrieved information into a predetermined format as formatted data" as Acacia asserts, since the end result of both steps is the same "formatted data."

POINT XX (JCC # 25)

THE ORDER OF THE STEPS (claim 44)

Round 3 Defendants' Proposed Construction

> The additional steps of claim 44 is part of the step of "placing the retrieved information" step of claim 41.

Argument

Acacia agrees that the step of claim 44 is part of the step of "placing the retrieved information" of claim 41. (JCC #25.) Acacia, however, argues that "the steps of claim 44 are performed either before, after, or simultaneously with the" placing step of claim 41. (*Id.*) This cannot be the case. For example, claim 44 calls for "converting digital signals of the retrieved information into formatted data with a predetermined format." This cannot happen either before or after the claim 41 step of "placing the retrieved information into a predetermined format as formatted data" as Acacia asserts, since the end result of both steps is the same "formatted data."

POINT XXI (JCC # 26)

"SEPARATELY STORING A PLURALITY OF FILES, EACH INCLUDING COMPRESSED, SEQUENCED DATA BLOCKS" (claim 45)

Round 3 Defendants' Proposed Construction

This term renders the claim indefinite.

Argument

Dependent claim 45 of the '992 patent is inconsistent with and cannot be understood in light of claim 41 from which it depends. Because the claim is "insolubly ambiguous" and not "amenable to construction," it is indefinite under 35 U.S.C. § 112. *See Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1358 (Fed. Cir. 2003).

Claim 41 recites a "method of transmitting information to remote locations" which involves storing "as a file" the "compressed, formatted and sequenced data blocks" and "sending at least a portion of the file" to a remote location. Claim 45 adds "separately storing a plurality of files, each including compressed, sequenced data blocks." This requirement renders claim 45 indecipherable. The claim does not indicate where "compressed, sequenced data blocks" come from because, unlike the file stored in the second storing step of claim 41, they do not have to be derived from information that was retrieved from the source material library. In addition, the separately stored "plurality of files" in claim 45 renders the final step in claim 41 of "sending at least a portion of *the* file to one of the remote locations" indefinite as to which file "the file" refers to. In sum, there is no way for one to know how the separately stored "plurality of files" of claim 45 relate to the "method of transmitting information" described in claim 41.

POINT XXII (JCC # 27)

THE ORDER OF THE STEPS (claim 45)

Round 3 Defendants' Proposed Construction

> If the Court finds that claim 45 of the '992 patent is not indefinite, then the step of claim 45 must be performed as part of the "storing as a file" step of claim 41.

Argument

Acacia agrees that "[t]he step of claim 45 is part of the step of 'storing as a file . . .' of claim 41." (JCC #27.) Acacia, however, argues that "the step of claim 45 is performed either before, after, or simultaneously with the" storing as a file step. (*Id.*) It is impossible to tell if this makes sense or not, since, for the reasons discussed in Point XXI, the storing of a "plurality of files" in claim 45 cannot be squared with the language of claim 41.

POINT XXIII (JCC # 28)

"RECEIVING TRANSMISSION REQUESTS TO TRANSMIT AVAILABLE ITEMS" (claim 46)

Round 3 Defendants' Proposed Construction

> Claim 46 is indefinite.

Argument

Given that claim 46 depends from claim 45 which, as explained above, is indefinite, claim 46 is indefinite as well.

POINT XXIV (JCC # 29)

THE ORDER OF THE STEPS (claim 46)

Round 3 Defendants' Proposed Construction

> If the Court finds that claim 46 of the '992 patent is not indefinite, the step of claim 46 must be performed in the order recited in the claim:
>
> 1. "generating a listing of available items";
> 2. "receiving transmission requests . . .";

3. “retrieving stored formatted data blocks . . . .”

Argument

Acacia agrees that “[t]he steps of claim 46 are performed” in the order recited. (JCC #29.) Acacia, however, argues that “the steps of claim 46 . . . may be performed before, after, or simultaneously with any other step of claim 41.” (*Id.*) This cannot be the case. For example, claim 46 calls for “retrieving stored formatted data blocks corresponding to requests from users.” This cannot happen, for example, before the claim 41 step of “placing the retrieved information into a predetermined format as formatted data.” Since the formatted data does not exist before that step, it would be impossible to retrieve it.

POINT XXV (JCC # 45)

“SENDING A REQUEST, BY THE USER TO THE TRANSMISSION SYSTEM, FOR AT LEAST A PART OF THE STORED INFORMATION TO BE TRANSMITTED TO A RECEPTION SYSTEM ASSOCIATED WITH A RECEIVING SYSTEM AT ONE OF THE REMOTE LOCATIONS SELECTED BY THE USER” (’275, claims 2, 5)

Round 3 Defendants’ Proposed Construction

> When the user requests “at least a part of the stored information,” the user chooses the premises, from among a plurality of (two or more) premises, to which the information will be sent. Each of the premises from which the user chooses has a receiving system to which the information can be transmitted. The premises chosen by the user must be different from the premises at which the user makes the request.
>
> The request by the user to the transmission system “for at least a part of the stored information” must include an identification of the specific remote location selected by the user.
>
> The “reception system” must be located at the head end of a cable television system.

Argument

This claim limitation generally tracks the claim 19 limitation of “sending a request, by the user to the transmission system, for at least a part of the stored information to be transmitted to the one of the receiving systems at one of the remote location selected by the user,” which is addressed in Point III above. The difference is that, instead of the information being transmitted from the transmission system to the receiving system at the remote location the user selects, the information is transmitted from the transmission system to a reception system associated with the receiving system at the remote location selected by the user.[46] Nonetheless, because claims 2 and 5, like claims 19 and 47 of the '992 patent, require that the user select a remote location with a receiving system, the construction of this portion of the limitation is the same for all of these claims. Round 3 defendants construed the limitation as follows:[47]

> When the user requests "at least a part of the stored information," the user chooses the premises, from among a plurality of (two or more) premises, to which the information will be sent. Each of the premises from which the user chooses has a receiving system to which the information can be transmitted. The premises chosen by the user must be different from the premises at which the user makes the request.
>
> The request by the user to the transmission system "for at least a part of the stored information" must include an identification of the specific remote location selected by the user.

As discussed above, however, claims 2 and 5 differ from claims 19 and 47 in that the selected remote location is not the location to which the information is sent by the transmission system. Claims 2 and 5 call for the transmission system to send the information to the "reception system," not the "receiving system" which is at the remote location the user selected. However, because these claims require that the reception system be "associated with" the receiving system, by selecting the receiving system the user also selects the reception system. The receiving system will receive the information, in uncompressed form, when it is played back in the final "playing back" step of claims 2 and 5.

This reception system claim limitation also requires that the reception system be located at the head end of a cable television system because that is exactly what the applicants told the examiner the limitation meant. In a Preliminary Amendment filed in the ’275 application shortly after the final amendments to the ’992 pending claims were made, applications provided amendments to three pending claims that closely tracked the amendments that were made to the same claims in the ’992 application. The applicants argued that the only difference between the amendments made to the claims in the ’275 and ’992 applications was that the ’275 claim amendments added the limitation of a reception system *at a head end*: “The amendments to the claims are similar to those made in allowed claims 1, 18, and 22 *but add a reception system located at the head end of a cable television reception system.*” (’275 4/2/92 Preliminary Amendment; Benyacar Decl., Ex. H, p. 5.) ’992 application claim 18 issued as claim 19 of the ’992 patent, and ’275 application claim 18 issued as claim 2 of the ’275 patent. Therefore, what the applicants were telling the examiner is that the only difference between claim 19 and claim 2 is that claim 2 required a reception system at a head end. The applicants are bound by this statement. *See Microsoft Corp.*, 357 F.3d at 1349-50; *Storage Tech. Corp., v. Cisco Sys., Inc.*, 329 F.3d 823, 835 (Fed. Cir. 2003).

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[46] The language of this limitation itself is ambiguous as to whether the reception system or the receiving system has to be at "one of the remote locations." However, because the preamble of claims 2 and 5 refer to "receiving systems at remote locations," and this claim limitation refers to "one of *the* remote locations" of the preamble, it appears that it is the receiving system that is at the remote location which the user selects for reception of the information from the transmission system.

[47] Acacia agrees the construction should be the same. (Acacia Br. p. 94.)

As discussed above, claim 5 was added in an amendment dated January 12, 1993 (as application claim 34), and was said to add the transmission media to application claim 18: “Specifically, new independent claims 33-35 further define the transmission media (claim 33), the distribution media (claim 34) and the reception media (claim 35).” (Benyacar Decl., Ex. I.) In other words, claim 5 is the same as claim 2 except for the addition of the “optical fiber communication path” in the body of the claim. Claim 5 too, then, requires a reception system at a cable head end.

POINT XXVI (JCC # 4, #46, #48)

“PLAYING BACK THE STORED COPY OF THE INFORMATION FROM THE RECEPTION SYSTEM TO THE RECEIVING SYSTEM AT THE SELECTED REMOTE LOCATION AT A TIME REQUESTED BY THE USER” (’275, claims 2, 5)

Round 3 Defendants’ Proposed Construction

The reception system must play back the stored copy directly onto the receiving system.

> The “receiving system” must be a device on which playback can occur - a device which itself can display video content or play audio content directly to a user, such as a television or a radio. (The “receiving system” cannot be a set top box.)
>
> “Playback” and “playing back” refer to the process of sending uncompressed signals to a device, such as an audio amplifier and/or television, on which video information can be displayed and/or audio information heard. These terms are construed similarly in other claims of the ’992 and ’275 patents.
>
> See also the construction of “time requested by the user” in Point IV above.

Argument

The constructions of “time requested by the user” and “playing back” in claims 2 and 5 are explained in Point IV above, and they have the same meaning in claims 2 and 5 that they have in claims 19 and 47 of the ’992 patent. As Acacia correctly observes, however, “receiving system” is used differently in claims 2 and 5 compared to the way it is used in the ’992 claims.[48] (Acacia Br. p. 94.)

The last element of both claims 2 and 5 call for the information stored in the reception system to be “played back” to the receiving system. The “playback system” is described in the patent as “a TV or audio amplifier” which can itself display video content or play audio content directly to a user. This is consistent with the definition of “playback” in the dictionaries relied on by Acacia:

- “the action of reproducing recorded sound or pictures often immediately after recording.” Webster’s Third New International Dictionary, p. 1737 (2002).
- “A term used to denote reproduction of a recording.” IEEE 100: The Authoritative Dictionary of IEEE Standard Terms, 7th Ed., p. 834, IEEE Press (2000).

Therefore, if Acacia is correct that the receiving system need not be a device which can display video content or play audio content directly to a user, such as a television or a radio, then the recorded information is not being reproduced at all, meaning there is no playback. Acacia’s construction thus contradicts the plain language of the claim.

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48 For this reason, the Round 3 defendants do not consider “receiving system” as used in the ’275 patent to be a term that the Court has already construed, and we are therefore addressing it now.

Acacia argues that Round 3 defendants' construction is wrong because the specification discloses "that the play back signal is either sent to a playback device (television or audio amplifier) or is sent to an audio/video recorder for recording." (Acacia Br. at 103.) That is not what the passage relied on by Acacia states. It states is that the signals *are* sent "to a playback system such as a TV or audio amplifier" and "*may also*" be sent "to an audio/video recorder of the user." (17:25-28.) The signals must be sent to the playback device, and may optionally be sent to an audio/video recorder.

POINT XXVII (JCC #7)

"USER" ('992, claims 19, 47 and '275, claims 2, 5)

Round 3 Defendants' Proposed Construction

A user is a human.

Argument

The term "user" is used in the specification exclusively to refer to a human. For example, a user is repeatedly referred to as a "he or she" (Cols. 3:58-60; 12:10-12; 12:20-21; 18:53-59), and users are described doing such things as making telephone calls from work and then going home (Col. 5:18-21), making calls and typing commands into a computer (Col. 3:54-58), "remotely select[ing] audio/video material from any location that has either telephone service or a computer" (Col. 1:62-66), and watching, listening to and viewing material (Cols. 3:60; 5:28). Since Acacia never disputes that a user is a human, Round 3 defendants do not feel it is necessary to itemize all of the overwhelming intrinsic evidence for this common sense proposition.

The Court should construe "user" to mean "a human."

Respectfully submitted,

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